

REMARKS

Upon entry of the present Amendment, claims 9 and 11-19 will remain pending in the above-identified application and stand ready for examination by the Examiner.

The above amendment to claim 9 does not incorporate new matter into the application as originally filed. In this regard, the amendment simply deletes the phrase "or a mutation or variation thereof," from claim 9. This deletion is based upon statements set forth in the Honorable Board of Appeals' Decision of February 14, 1996, which was made in the matter of this case.

Rejections Under 35 USC § 112, First Paragraph

In the Honorable Board's Decision of February 14, 1996, the Board Members affirmed the Examiner's prior rejection of claim 9 under 35 USC § 112, first paragraph, as based on a non-enabling disclosure. Thereafter, the Board also set forth a new ground of rejection under 35 USC § 1.196(b) of claims 11-19 under 35 USC § 112, first paragraph, as being based on an non-enabling disclosure. It is submitted that the present amendment of claim 9 obviates each of the outstanding rejections under 35 USC § 112, first paragraph. Comments set forth in the Board of Appeals' Decision at page 5, line 7 to page 8, line 2, support this contention.

Further to the above, it is noted that MPEP § 1214.01, at page 1200-28 (6th ed., 1st rev.) specifically states as follows

concerning amendments made in response to a USPTO Board of Appeals Decision in which a new rejection under 37 CFR § 1.196(b) is set forth.

If the Board's Decision in which the rejection under 37 CFR § 1.196(b) was made includes an affirmance of the examiner's rejection, the basis of the affirmed rejection is not open to further prosecution. If the appellant elects to proceed before the Examiner with regard to the new rejection, the Board's affirmance will be treated as non-final for purposes of seeking judicial review, and no request for reconsideration of the affirmance need be filed at that time. Prosecution before the Examiner of the 37 CFR § 1.196(b) rejection can incidentally result in overcoming the affirmed rejection even though the affirmed rejection is not open to further prosecution. Therefore, it is possible for the application to be allowed as a result of the limited prosecution before the Examiner of the 37 CFR § 1.196(b) rejection. If the application becomes allowed, the case should not be returned to the Board. (emphasis added)

Based upon the above considerations, as well as the amendment made herein to claim 9, an early allowance of each of pending claims 9 and 11-19 is respectfully requested.

Should the Examiner have any questions regarding this matter, he is respectfully requested to contact Mr. John W. Bailey (Reg. No. 32,881), who may be reached in the Washington, DC, area at (703) 205-8000.

Serial No. 07/330,446
Examining Group 1814

Please charge any fees or credit any overpayment pursuant to
37 CFR § 1.16 and 1.17 to Deposit Account No. 02-2448.

Respectfully submitted,

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By

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